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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/532,576	03/22/2000	Peter W. Hamilton	7995	8660

27752 7590 01/15/2003

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT PAPER NUMBER

1772

DATE MAILED: 01/15/2003 //

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/532,576

Applicant(s)

HAMILTON ET AL.

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/6/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 58-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-57, in Paper No. 10 is acknowledged. The traversal is on the ground(s) that process claims which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance. This is not found persuasive because allowable subject matter has not been identified at this time. However, if allowable subject matter is determined in the future rejoinder may be proper at that time. Furthermore, the examiner has already shown that the inventions are distinct for the reasons given in the paper #6 and have acquired a separate status in the art as shown by their different classification and have acquired a separate status in the art because of their recognized divergent subject matter and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Applicant further traverse the restriction requirement of the Group II claims because the search and examination of the entire applicant can be made without a serious burden. Applicant states that the Examiner would likely search the class and subclass listed in the restriction requirement for a complete examination of the product claims of Group I. As stated in the restriction requirement the search required for Group I is not required for Group II. The class and subclasses provided in the restriction requirement are merely the initial classification of each group and is by no means the entire search for that particular group. Furthermore, since each group is handled in different classes and each class is handle by different art units, it is in

Applicant's best interest, for proper examination, to have the claims examined by a person best versed in those specific art areas.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-4, 13 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Blanc-Brude (5,906,883).

Blanc-Brude discloses an adhesive sheet comprising a film having a front and back face, where the front face has a plurality of collapsible, non-adhesive protrusions extending outwardly from the front face and adhesive in the non-raised regions disposed between the protrusions (col.

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2, lines 23-37 and figure 2). The adhesive sheet further comprises an external sheet (substrate), such as wall paper, bonded to the back face of the film (col. 2, lines 45-49). The film layer can be made of a thermoplastic material, cellulose paste, foam, polyurethane foam, vinyl or polyethylene (col. 3, lines 6-14).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun et al. (5,589,246) in view of Blanc-Brude (5,906,883).

Calhoun discloses an adhesive article used in a variety of applicants, such as in decorative and informative markings on vehicles; signage; buildings; fascia; awnings; taps, such as transfer tapes, double-sided tapes, photographic and other layout tapes; as well as masking tapes for paint spraying; wallpaper and the like (col. 6, lines 25-30). The adhesive article comprising a carrier film layer provided with a plurality collapsible protrusions with adhesive filling the non-raised region between the protrusions (col. 6, lines 41-60 and figure 1). The carrier can be made from polyolefins, such a high density polyethylene, low density polyethylene, and polyethylene copolymers (col. 8, lines 18-41). The projections can have any desired shape, dimension, and pattern. For example, they can be flattened on the top, convex,

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have a small concave indentation in the top to accommodate a small hole in the top to allow air bleed (col. 6, lines 54-60).

The size and shape of the recesses and projections in the embossed carrier web are not normally critical, but should be selected to match the intended application. The depth of the recesses is also not critically limited, but is normally less than 0.25 mm as are the thickness of the typical adhesives. The height of the projections must be larger than the thickness of the adhesive coated on the recessed surface portion. The three dimensional shape of the recesses and projections can easily be controlled if desired and tailored to specific applications. Cross-sections of the three dimensional shapes, which can be of a wide variety of shapes, including oval, circular, polygonal, or rectangular. See column 9, lines 7-19.

Although Calhoun does not explicitly teach the limitations a compressive force of at least about 0.5 psi to about 15 psi is required to collapse said protrusions or adhesive non-raised region having peel force of at least about 0.3 pounds per linear inch, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. polyolefins, more specifically, high density polyethylene) and in the similar production steps (i.e. embossing) used to produce the adhesive article. The burden is upon the Applicant to prove otherwise.

Calhoun discloses all the limitations of the instant invention except for a substrate on the back of the film layer.

Blanc-Brude discloses an adhesive sheet comprising a film having a front and back face, where the front face has a plurality of collapsible, non-adhesive protrusions extending outwardly from the front face and adhesive in the non-raised regions disposed between the protrusions (col.

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2, lines 23-37 and figure 2). The adhesive sheet further comprises an external sheet (substrate), such as wall paper, bonded to the back face of the film (col. 2, lines 45-49). The film layer can be made of a thermoplastic material, cellulose paste, foam, polyurethane foam, vinyl or polyethylene (col. 3, lines 6-14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add an external sheet, such as wall paper, as taught by Blanc-Brude to the adhesive article of Calhoun. One would be motivated to add the wall paper layer to Calhoun because it would add a decorative appearance to Calhoun, when Calhoun's article is used as wallpaper.

Since Calhoun discloses that the size and shape of the recesses and projections in the embossed carrier web are not normally critical, but should be selected to match the intended application, the exact number density of protrusions, protrusion height, protrusion center-to-center distance, base diameter, protrusion base surface area, and film thickness are deemed to be a cause effective variable with regard to the adhesion quality of the article. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as number density of protrusions, protrusion height, protrusion center-to-center distance, base diameter, protrusion base surface, and film thickness through routine experimentation in the absence of a showing of criticality in the claimed combined protrusion variables. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill would have been motivated to optimize these protrusion variables in order to match the intended application of the adhesive article, as taught by Calhoun in column 9, lines 7-19.

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6. Claims 1-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton et al. (5,589,246) in view of Blanc-Brude (5,906,883).

Hamilton discloses a flexible film coated with pressure sensitive adhesive for releasable sealing to a target surface, and more particularly premature sticking to a target surface during film positioning thereon (col. 1, lines 7-10). The composite film is useful in tapes, labels, and other articles using pressure sensitive adhesive to adhere an adhesive coated surface to a target surface (col. 1, lines 18-20). The composite film comprises a flexible film layer provided with a plurality collapsible conical shaped protrusions with adhesive filling the non-raised region between the protrusions (col. 5, line 64 to col. 6, line 13 and figure 10). The conical protrusions have a base diameter of about 0.015 inches to about 0.030 inches, a center-to-center spacing from 0.03 to 0.06 inches, and a protrusion height of about 0.004 inches to 0.012 inches (col. 6, lines 21-27). The preferred film material is 0.001 inch nominal thickness low density polyethylene (col. 6, lines 27-29). It is desirable to provide a stiffness which is sufficient to withstand a pressure of 0.4 pounds per square inch without collapsing protrusions to where the adhesive contacts a target surface (col. 8, lines 2-5), which reads on requiring a compressive force larger than 0.4 pounds per square inch to collapse the protrusions.

Although Hamilton does not explicitly teach the limitations number density of protrusions or protrusion base surface area, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the that the protrusion have the same base diameter and center-to-center distance between the protrusions to make the composite film. The burden is upon the Applicant to prove otherwise.

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Although Hamilton does not explicitly teach the limitation adhesive non-raised region having peel force of at least about 0.3 pounds per liner inch, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. polyolefins, more specifically, polyethylene) and in the similar production steps (i.e. embossing) used to produce the adhesive article. The burden is upon the Applicant to prove otherwise.

Hamilton discloses the claimed invention except that the film is low density polyethylene instead of high density polyethylene. Calhoun in col. 8, lines 18-41, shows that low and high density polyethylene are equivalent materials in the art. Therefore, because these two materials were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute low density polyethylene for high density polyethylene.

Hamilton discloses all the limitations of the instant invention except for a substrate on the back of the film layer.

Blanc-Brude discloses an adhesive sheet comprising a film having a front and back face, where the front face has a plurality of collapsible, non-adhesive protrusions extending outwardly from the front face and adhesive in the non-raised regions disposed between the protrusions (col. 2, lines 23-37 and figure 2). The adhesive sheet further comprises an external sheet (substrate), such as wall paper, bonded to the back face of the film (col. 2, lines 45-49). The film layer can be made of a thermoplastic material, cellulose paste, foam, polyurethane foam, vinyl or polyethylene (col. 3, lines 6-14).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to add an external sheet, such as wall paper, as taught by Blanc-Brude to the adhesive article of Hamilton. One would be motivated to add the wall paper layer to Hamilton because it would add a decorative appearance to Hamilton, when Hamilton's article is used for masking the wall.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

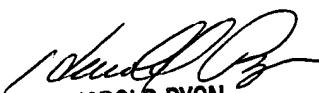
If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

1/10/03




HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

1/13/03